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10/621,777	07/17/2003	John Randall Fredlund	67244HF-P	1678

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EXAMINER

LEE, CHEUKFAN

ART UNIT

PAPER NUMBER

2627

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,777

Applicant(s)

FREDLUND ET AL.

Examiner

Cheukfan Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date (see cont. page).
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Attachement(s)

3) Information Disclosure Statements (PTO-1449), Mail Dates 7/17/2003, 4/14/2004, 3/15/2004

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1. Claims 1-29 are pending. Claims 1 and 16 are independent.

2. Claims 13 and 29 are objected to because of the following:

Claim 13 should depend on claim 12, not claim 1, since the basis for "said index print" is set forth in claim 12 and not in claim 1.

Claim 29 is written to depend on claim 26 (instead of on claim 25). However, to the examiner, it seems that claim 29 was intended to be written to depend on claim 25 since it seems that claims 17-29 were intended to be written to correspond to claims 3-15. Please clarify.

The obviousness type double patenting rejection addressed below is based on the assumption that claim 13 depends on claim 12 and claim 29 depends on claim 25.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-29, insofar as claim 13 is understood to depend on claim 12 and claim 29 is understood/assumed to depend on claim 25 (instead of claim 26), are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,600,572. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons given below.

Claim 1 claims the preamble, the steps of a) "obtaining ...", b) "storing ...", and c) "facilitating electronically ordering ..." of patent claim 1, except that in the step of "facilitating ..." of claim 1 the ordering is "by said customer". Claim 1 differs from patent claim 1 in that claim 1 does not recite the steps d) "providing said image product" and e) "delivering said image product" of patent claim 1 but recites the step of "facilitating viewing of the images and associated order number by said customer prior to ordering image products with respect to said at least one image", which is not claimed in patent claim 1.

With respect to the claim 1 limitation "by said customer" in the step of "facilitating remote electronically ordering ...", reading the preamble of patent claim 1 "A method for remotely ordering image products or services with respect to digitally stored images", one of ordinary skill in the art would have understood that the ordering of the image products or services is by a customer. Therefore, it would have been obvious to one of

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ordinary skill in the art at the time the invention was made to facilitate remote electronically ordering an image product or service by the customer with respect to the at least one image over a communication network using the order number.

With regard to the patent claim 1 steps d) and e) that are not claimed in claim 1, i.e., "providing said image product" and "delivering said image product", In re Karlson (In re Karlson, 136, USPQ 184 (CCPA 1963)) states the following: "It is well settled, however, that omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before." In re Nelson, 40, CCPA 708, 198 F.2d 837, 95 USPQ 82; In re Eliot 22 CCPA 1088, 76 F2d 309, 25 USPQ 111. In the instant case, omission of the steps d) and e) in a combination of the steps of patent claim 1 is an obvious expedient because the remaining steps perform the same functions as before. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to omit the patent claim 1 steps d) and e).

With regard to the claim 1 step "facilitating viewing of the images and associated order number by said customer prior to ordering image products with respect to said at least one image", which is not recited in patent claim 1, since claimed in patent claim 1 is a method for remotely ordering image products or services with respect to the digitally stored images, one of ordinary skill in the art would have realized the advantage of viewing the images and associated order number (that identifies the digital file) (in step b) of patent claim 1) by the customer prior to ordering by the customer, which advantage is knowing before ordering. Therefore, it would have been obvious to one of

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ordinary skill in the art at the time the invention was made to facilitate viewing of the images and associated order number by the customer prior to ordering image products with respect to the at least one image.

Claim 2 claims the step of "providing said image product or service to a party designated by said customer". As discussed for claim 1 above, patent claim 1 recites the step d) of "providing said image product". The difference between the claim 2 step and the patent claim 1 step d) is that that the claim 1 step requires that the image product or service is provided to a party designated by the customer. With the patent claim 1 step of providing said image product, one of ordinary skill in the art would have realized that the image product is provided to some one. A party designated by the customer of claim 2 is some one. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the image product or service to a party designated by the customer as claimed in claim 2.

Claims 3-15 are identical to patent claims 2-12, 14, and 13, respectively.

Claim 16 claims the preamble, the steps of a) "obtaining ...", b) "storing ...", c) "facilitating electronically ordering ...", and "providing said image product" of patent claim 1, except that in the step of "facilitating electronically ordering..." of claim 16 the ordering is "by said customer" and the ordering over a communication network using said order number is "by a customer for delivery to a party designated by said

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customer”, and the step of “providing” is providing to “said designated party”. Claim 16 differs from patent claim 1 in that claim 16 does not recite the step e) of “delivering said image product” of patent claim 1 but recites the step of “facilitating providing of said order number to said customer”, which is not claimed in patent claim 1.

With respect to the claim 16 limitation “by said customer” in the step of “facilitating electronically ordering ...”, reading the preamble of patent claim 1 “A method for remotely ordering image products or services with respect to digitally stored images”, one of ordinary skill in the art would have understood that the ordering of the image products or services is by a customer. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to facilitate remote electronically ordering an image product or service by the customer with respect to the at least one image over a communication network using the order number.

As to the claim 16 limitation in the same step of “facilitating electronically ordering ...”, i.e., the limitation “for delivery to a party designated by said customer”, with the patent claim 1 step of “facilitating electronically ordering an image product or service with respect to said at least one image over a communication network using said order number”, one of ordinary skill in the art would have realized that the image product or service communicated over the communication network is for delivery to a party, and since the ordering is by the customer as discussed above for claim 16, it would have been obvious to one of ordinary skill in the art to have the party designated by the customer who is ordering the product or service.

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With regard to the claim 16 step of providing said image product or service “to said designated party”, based on the reason of obviousness given for claim 16 above with respect to the limitation “for delivery to a party designated by said customer” and the fact that patent claim 1 recites the step d) of providing said image product, one of ordinary skill in the art would have understood that the image product or service is intended for the designated party. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the image product or service to the designated party as claimed in claim 16.

With regard to the patent claim 1 step of “delivering said image product” that is not claimed in claim 16, please refer to the discussion above for claim 1 with respect to the use of *In re Karlson*, omission of an element, and reason of obviousness given for claim 1.

With regard to the claim 16 step of “facilitating providing of said order number to said customer”, though this step is not claimed in patent claim 1, one of ordinary skill in the art would have realized the advantage of providing the order number to the customer, which is to enable the customer to make the ordering using the customer number as in the patent claim 1 step c) of facilitating electronically ordering. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the patent claim 1 the step of facilitating providing of the order number to the customer.

Claims 17-29 are identical to patent claims 2-12, 14, and 13, respectively.


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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee whose telephone number is (571) 272-7407. The examiner can normally be reached on 9:30 a.m. to 6:00 p.m., Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, (currently unknown) can be reached on (currently unknown). The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cheukfan Lee
November 23, 2005



Cheukfan Lee